

58716.US

**REMARKS**

Claims 1-8 are in the case. Claims 1-15 are rejected under 35 USC § 102 over USPN 6,027,669 to Miura et al. Claims 1-2, 5, and 9 are rejected under 35 USC § 103 over USPA 2001/0000912 to Kambe et al. Claim 1 has been amended and claims 9-20 are hereby cancelled. No new matter has been introduced by the amendments, which are supported by the disclosure of the original claims and the specification, such as in paragraph [0033]. Reconsideration and allowance of the claims are respectfully requested.

**CLAIM REJECTIONS UNDER §102**

Claims 1-8 are rejected over Miura et al. Independent claim 1 claims, *inter alia*, an electrically conductive fluid that is substantially free of materials that are reactive within a desired operating voltage potential range and substantially free of materials that inhibit desired reactions within the desired operating voltage potential range, *the electrically conductive fluid being chemically abrasive to the layer on the substrate*, and abrasive particles having a size that is small enough for the particles to substantially remain in suspension in the electrically conductive fluid and is large enough for the particles to provide a desired degree of erosion of the layer on the substrate when the abrasive electrolyte solution is forced against the layer on the substrate.

Miura et al. do not describe a fluid that is chemically abrasive to the layer on the substrate. Thus, claim 1 patentably defines over Miura et al. Reconsideration and allowance of claim 1 are respectfully requested. Dependent claims 2-8 depend from independent claim 1, and contain additional important aspects of the invention. Therefore, dependent claims 2-8 patentably define over Miura et al. Reconsideration and allowance of dependent claims 2-8 are respectfully requested.

**CLAIM REJECTIONS UNDER §103**

Claims 1-2 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kambe et al. Independent claim 1 claims, *inter alia*, an electrically conductive fluid that is substantially free of materials that are reactive within a desired operating voltage

58716.US

potential range and substantially free of materials that inhibit desired reactions within the desired operating voltage potential range, *the electrically conductive fluid being chemically abrasive to the layer on the substrate*, and abrasive particles having a size that is small enough for the particles to substantially remain in suspension in the electrically conductive fluid and is large enough for the particles to provide a desired degree of erosion of the layer on the substrate when the abrasive electrolyte solution is forced against the layer on the substrate.

Kambe et al. do not describe a fluid that is chemically abrasive to the layer on the substrate. Thus, claim 1 patentably defines over Kambe et al. Reconsideration and allowance of claim 1 are respectfully requested. Dependent claims 2 and 5 depend from independent claim 1, and contain additional important aspects of the invention. Therefore, dependent claims 2 and 5 patentably define over Kambe et al. Reconsideration and allowance of dependent claims 2 and 5 are respectfully requested.

## CONCLUSION

Applicants assert that the claims of the present application patentably define over the prior art made of record and not relied upon for the same reasons as given above. Applicants respectfully submit that a full and complete response to the office action is provided herein, and that the application is now fully in condition for allowance. Action in accordance therewith is respectfully requested.

In the event this response is not timely filed, applicants hereby petition for the appropriate extension of time and request that the fee for the extension be charged to deposit account 12-2355. If other fees are required by this amendment, such as fees for additional claims, such fees may be charged to deposit account 12-2252.

Sincerely,

LUEDEKA, NEELY & GRAHAM, P.C.

By: 

Rick Barnes, 39,596

2006.03.10